

# Lackenbach Siegel, LLP

INTELLECTUAL PROPERTY  
ATTORNEYS SINCE 1923

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said plane being perpendicularly disposed to said sleeve central axis,  
whereby said tubular body and said sleeve provides a uniform torque transfer to  
said tool bit member during said use.

## REMARKS

The gravamen of the art rejection is the argument that one "merely substitutes" the Beran "sleeve" in Harrison, which substitution purportedly meets the claim limitations and is within the level of ordinary skill at the time of the claimed invention was made, and does not include knowledge gleaned only from applicants' disclosure, and that Harrison would remain operable as a multi-functional tool.

The substitution of Beran in Harrison, however, would not result in the presentlyclaimed multi-functional tool. Beran must be reconstructed against its explicit teachings to meet the claim limitations. Beran necessarily requires an acutely angled "sleeve" of rectilinear construction, wherein the bottom is open to expose the cutting or sawing edge and the top edge is extended to provide a bearing surface to take up the downwardly exerted cutting or sawing forces. The Beran sleeve is therefore necessary acutely angled. On analysis, one skilled in the art who allegedly would "merely substitute" Beran in Harrison does not provide the multi-tool construction as claimed. One must instead deconstruct and reconstruct Beran against the claimed teachings in Beran in an attempt to meet applicants' claims. This is not, as argued, some supposed permissible form of Section 103 hindsight. This substitution is contrary to the principle of In re McLaughlin, 443 F. 2d 1392, 170 USPQ 209 (CCPA 1971), cited at p.6 of the office action. That is, the deconstruction and reconstruction of Beran is the very "knowledge taken from applicants' disclosure"; hindsight knowledge precludes a prima facie showing of obviousness. The claims, as amended, set out these patentable features.

Harrison teaches away from pivotally stowing a torque sleeve in a multi-tool handle. Beran teaches away from a torque sleeve construction. A hindsight disregard by both teachings and reconstruction, are required in an attempt to meet the claims.

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No new matter has been added. The claims were previously represented and the patentable features of claims 104-106 were in the amendment filed February 3, 2004. The patentable features of claims 104-106 were not specifically addressed in the outstanding office action.

Favorable reconsideration is respectfully requested.

Applicants' attorney confirms the scheduled June 7, 2004 interview, for 11:30 a.m. This interview is for resolving outstanding issues, if any exist. This would be a first interview in this application.

Sincerely yours,

LACKENBACH SIEGEL LLP

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MF:k

c: Wayne Anderson, (Via facsimile 631-586-4126)